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Total Number of Pages in This Submission

13

Application Number

09/482,773

Filing Date

JANUARY 13, 2000

First Named Inventor

DREHER, et al.

Art Unit

1617

Examiner Name

YU, Gina C.

Attorney Docket Number

99.49US

ENCLOSURES (Check all that apply)

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Fee Transmittal Form

☐

Fee Attached

☐

Amendment/Reply

☐

After Final

☐

Affidavits/declaration(s)

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Extension of Time Request

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Express Abandonment Request

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Information Disclosure Statement

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Certified Copy of Priority Document(s)

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Reply to Missing Parts/
Incomplete Application

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under 37 CFR 1.52 or 1.53

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Drawing(s)

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Licensing-related Papers

☐

Petition

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Petition to Convert to a

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Provisional Application

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Power of Attorney, Revocation

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Change of Correspondence Address

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CD, Number of CD(s) _____

☐ Landscape Table on CD

Remarks

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After Allowance Communication to TC

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Appeal Communication to Board (4 pgs)
of Appeals and Interferences

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Appeal Communication to TC
(Appeal Notice, Brief, Reply Brief)

☐

Proprietary Information

☐

Status Letter

☒

Other Enclosure(s) (please identify
below):

Pending Claims on Appeal (2 pgs) ~ in
Postcard duplicate

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

ESTEE LAUDER COMPANIES

Signature

Printed name

CYNTHIA R. MILLER, ESQ.

Date

JULY 26, 2005

Reg. No.

34,678

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Attorney Docket No.: 99.49US



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of Dreher, et al.

Group Art Unit: 1617

Serial No.: 09/482,773

Examiner: YU, Gina C.

Filed: January 13, 2000

For: **OPTICAL MAKEUP COMPOSITION**

REPLY TO EXAMINER'S RESPONSE TO APPEAL BRIEF

Commissioner for Patents
Attention: Board of Patent Appeals and Interferences
Alexandria, VA 22313-1450

Sir:

An Appeal Brief was filed November 26, 2004. A response to the Appeal Brief was mailed June 3, 2005.

In reply to the Examiner's Response, please enter the following remarks.

The Examiner has maintained the rejections of claims 1-7 and 9-11 in view of Kimura ('916) and Hineno ('174), and the rejection of claim 8 in view of the aforementioned references in combination with Hurst. The rejections are again respectfully traversed.

The Examiner has merely engaged in hindsight reconstruction of the claimed invention to establish her case of prima facie obviousness. Nevertheless, it is well-established that "While the test for establishing an implicit teaching, motivation, or suggestion is what the combination of these two statements...would have suggested to those of ordinary skill in the art, the two statements cannot be viewed in the abstract. Rather, they must be considered in the context of the teaching of the entire reference [emphasis added]. Further, a rejection cannot be

predicated on the mere identification...of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *In re Kotzab*, 54 USPQ2d 1313, 1317 (Fed. Cir. 2000).

Rather than considering the reference as a whole, the Examiner has used hindsight reconstruction to select the following isolated disclosure from Hineno ('174) as indicating the broad teachings of the reference to deprecate the claimed invention:

"The content of the composite powder in the external composition of the present invention can be selected, as required, depending on the form or the type of the composition, the purpose of incorporating the composite powder of the present invention and the like, and it shall not particularly be limited." (col. 7, lines 36-41 of Hineno).

Applicants do not disagree that the reference teaches that composite powders having essentially an unlimited number of interference colors may be produced according to the method in the reference for use for a great variety of purposes. As stated in the reference in col. 6, lines 6-12,

"This interference color mainly depends on the refractive index of the core particle, the refractive index of the coating component and the film thickness of the coating component in the composite powder of the present invention as mentioned above. That is, the desired interference color can be obtained from the composite powder of the present invention by properly adjusting these factors determining the interference color."

However, although the Examiner has interpreted her selected disclosure from Hineno to mean that any colorant may be used in the composite powder, for any purpose, there is nothing in Hineno which would lead one skilled in the art to believe that any composition can be utilized for any purpose. One skilled in the art would appreciate that Hineno more accurately teaches that, in formulating a composition, particular attention is to be paid to the type of compositions (e.g., makeup), and to the purpose for incorporating the composite powder into the makeup composition (e.g., to hide wrinkles). Nevertheless, the Applicants are not claiming a composition but a use.

Only certain compositions disclosed in the reference are indicated as useful for camouflaging wrinkles and those are found in Examples 1 and 2, including Tables 2 and 3, in columns 14-16 of the reference. Those compositions use only composite powder (1), the particles of which have a reddish reflectance. There is absolutely nothing in the reference which would suggest that a composition comprising a composite powder having a blue reflectance property would demonstrate any efficacy for hiding wrinkles. The only color that has any utility for this purpose is red.

In fact, considering the reference as a whole, it is notable that all of the examples for cosmetic compositions for application to the facial skin and the lips (facial cream, loose powder, foundations and lip cream) employ red interference composite powder (1) for the primary purpose of improving skin color (e.g., imparting a rosy tone to the skin). In all cases, an improvement in skin color was observed after application of the red interference powder-containing compositions to the skin.

Therefore, given, for the sake of argument, that the Examiner has provided a reasonable suggestion that would have led one skilled in the art to combine the relevant teachings of the applied references (i.e., using an interference powder-containing composition for improving skin color tone or for hiding wrinkles), the combined teachings would still not place the claimed method in the possession of one skilled in the art. Kimura teaches the use of a composite powder composition having a reflectance color (e.g. blue or red) which is complementary to a hyperpigmented portion of the skin (e.g. red or blue, respectively), to camouflage the hyperpigmented portion of the skin so that it appears similar to the surrounding skin. Kimura is completely silent about wrinkles. Hineno teaches that wrinkles in the skin may be covered by using a composition comprising a composite powder having a reddish reflectance. There is no connection of blue with wrinkles in either reference. The combination of Kimura and Hineno could only result in the teaching that a cosmetic composition having a reddish reflectance, as taught by Hineno, when applied to the skin, according to the method of Kimura for hiding a blue hyperpigmented portion of the skin, would also hide wrinkles when the hyperpigmented skin also includes wrinkles.

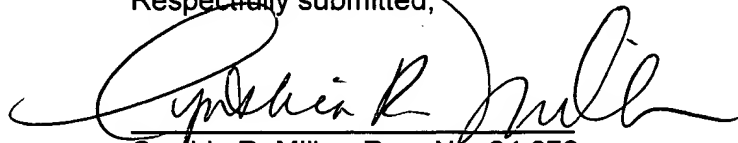
Hurst merely discloses the use of bismuth oxychloride to add luster to a cosmetic composition, and thereby enhance the wearer's natural complexion. Hurst is silent about

wrinkles and interference pigments. The combination of Hurst with Kimura and Hineno would result in a composition employing a red interference pigment and a luster. The combination of teachings could not lead one skilled in the art to the claimed method for hiding wrinkles.

Thus, in view of the teachings of Hineno, or Hineno and Hurst, one skilled in the art could not reasonably have been led to the conclusion that the method of Kimura of topically applying a composition comprising blue interference pigment to age-wrinkled skin would produce wrinkle hiding effects.

A copy of all claims (1 to 11), pending in this Appeal, also is attached hereto.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Cynthia R. Miller", written over a horizontal line.

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APPENDIX: THE CLAIMS ON APPEAL

1. (previously presented) A method of reducing the appearance of lines and wrinkles associated with aging of the skin, which comprises applying to the skin exhibiting lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment.
2. (original) The method of claim 1 in which the interference pigment has a blue reflectance.
3. (original) The method of claim 1 in which the interference pigment has only a blue reflectance.
4. (original) The method of claim 1 in which the composition comprises titanium dioxide.
5. (original) The method of claim 1 in which the composition comprises titanium dioxide and iron oxide.
6. (original) The method of claim 1 in which the composition further comprises at least one inorganic, non-matte, non-spherical powder.
7. (original) The method of claim 6 in which the powder is selected from the group consisting of bismuth oxychloride, boron nitride, barium sulfate, mica, sericite, muscovite, synthetic mica, titanium oxide coated mica, titanium oxide coated

bismuth oxychloride, titanium oxide coated talc, platelet iron oxides, aluminum powder, lauroyl lysine and platelet talc.

8. (original) The method of claim 1 in which the composition further comprises bismuth oxychloride.

9. (original) The method of claim 1 in which the composition comprises from about 1 to about 9% by weight of interference pigment.

10. (original) The method of claim 8 in which the composition comprises from about 2 to about 8% by weight of the interference pigment.

11. (original) The method of claim 10 in which the interference pigment has only a blue reflectance.